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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/069,394      | 04/15/2002  | Yasunori Ueno        | 112064              | 3613             |

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Oliff & Berridge  
PO Box 19928  
Alexandria, VA 22320

EXAMINER

RAIZEN, DEBORAH A

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2873

DATE MAILED: 04/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/069,394             | UENO, YASUNORI      |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Deborah A. Raizen      | 2873                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on 27 February 2004.

2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 1,2,4-11,13,15 and 19-22 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☒ Claim(s) 8,15 and 19-22 is/are allowed.

6) ☒ Claim(s) 1,2,5 and 6 is/are rejected.

7) ☒ Claim(s) 4,7,9-11 and 13 is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on 15 April 2002 and 27 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All    b) ☐ Some \*    c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

|   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 7 is objected to because of the following informalities: the last two lines of the claim recite: "when the difference in prescription between the left and right eyes is over a specific amount". Because the rest of the claim deals with matching old and new lenses, it appears that "the left and right eyes" is a mistake. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, 5, and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Shirayanagi (6,419,549, cited in paper no. 10 of June 3, 2003).
4. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

In regard to claim 1, Shirayanagi discloses a spectacle lens supply method in which a computer is set up on a spectacle lens order side (input and selecting devices col. 8, lines 20-25 and 36-38) and a computer that is connected to this order-side computer such that information

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can be mutually exchanged is provided on the manufacturer side (col. 8, line 26), and spectacle lenses are supplied by having the order-side computer and the manufacturer-side computer perform computations according to specific input operations and perform the processing required for the taking and/or placing of orders for spectacle lenses while exchanging information with each other (col. 8, lines 18-38; also, col. 11, lines 11, lines 57-60),

characterized in that when spectacle lens information, spectacle frame information, prescription values, layout information, processing instructions information, and other such processing condition data required for processing is transmitted by the order-side computer to the manufacturer-side computer (col. 11, lines 48-60), a lens design program installed on the manufacturer-side computer performs optical lens design tailored to the customer on the basis of the transmitted processing condition data (col. 11, lines 61-66 and col. 12, lines 19-27) so that base curves on the left and right convex surface sides approximate each other (col. 13, line 47-49) and at least one optical performance of the left and right lenses (col. 13, lines 49-51), which is selected among astigmatism (col. 14, lines 1-9), curvature of field, and distortion, is similar (Figs. 7A and 7B), when the difference in prescription between the left and right eyes is over a specific amount (6D, from Table 10: -4.0 for right and 2.0 for left), and the lenses are manufactured according to this design (col. 8, lines 18-35 and col. 12, lines 40-49).

In regard to claim 2, in the Shirayanagi spectacle lens supply method, the spectacle lens is a single vision lens (col. 13, lines 43-45).

In regard to claim 5, in the Shirayanagi spectacle lens supply method, the optical lens design is such that the difference in convex surface base curves of the left and right spectacle lenses is no more than 1 D (it is 0 because both are 3.00 diopter, col. 13, lines 52-54).

In regard to claim 6, in the Shirayanagi spectacle lens supply method, a display means (col. 11, line 40 and col. 12, lines 64-66) for comparing data including the lens shape before the curve matching and the prescription data for this lens, to data including the lens shape after the curve matching and the prescription data for this lens, is transferred to and displayed at the computer set up on the side where spectacle lens is ordered (inherently disclosed because Figs. 2A-4B are compared to Figs. 5A-7B, and Table 9 is compared to Table 10).

### ***Response to Arguments***

5. Applicant's arguments filed on 27 February 2004 with regard to claim 1 and Shirayanagi have been fully considered but they are not persuasive. Applicant asserts that Shirayanagi does not disclose a method wherein astigmatism of the left and right lenses is similar. As explained above, Shirayanagi does disclose that the astigmatism of the left and right lenses is similar (Figs. 7A and 7B), as well as the other limitations of the claim, such as front base curve matching.

### ***Allowable Subject Matter***

6. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art taken either singularly or in combination fails to anticipate or fairly suggest the limitations of claim 4, in such a manner that a rejection under 35 U.S.C. 102 or 103 would be proper.

The prior art fails to teach a combination of all the features in claim 4. For example, these features include the detailed steps recited in claim 1 and also the limitation that the convex surface curve of one lens is made to have an aspherical shape, in combination with all the other limitations of the claim. In the Shirayanagi method, the convex surface of each lens is spherical.

7. Claims 8, 15, and 19-22 are allowed.

The following is an examiner's statement of reasons for allowance: The prior art taken either singularly or in combination fails to anticipate or fairly suggest the limitations of claims 8, 15, and 19-22, in such a manner that a rejection under 35 U.S.C. 102 or 103 would be proper.

For claim 8, see paper no. 10 of June 3, 2003. Furthermore, although the claim is written in alternative format, including steps such as "a step of selecting or producing lens design data matching the new prescription values as lens design data for the new prescription values if no old data for that customer exists", the claim only makes sense if the system has all the recited steps, including the details of optical performance matching. The quoted limitation above (and the other alternative limitations, such as lines 13-17 on page 5 of the amendment, which is page 4 of CLM in the Image File Wrapper) is therefore seen as further limiting the claim, rather than broadening it.

Claims 19-22 depend on claim 8 and are therefore allowed as well.

The prior art fails to teach a combination of all the features in claim 15. For example, these features include the detailed steps recited, especially the limitation that the curved surface of the first refractive surface of at least one of the left and right spectacle lens is aspherical and

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the limitation that the optical performance is selected among astigmatism, curvature of field, and distortion, in combination with all the other limitations of the claim. Shirayanagi meets the other limitations of the claim, but does not meet the limitation regarding the aspherical first surface (only the back surface is aspherical in the Shirayanagi method).

Hayashi et al. (5,767,940) discloses matching the cylinder power of left and right lenses, but not the optical performance. Shtrayanagi et al. (US 2002/0039171) also appears relevant, especially paragraph 0011, but the reference does not explicitly disclose matching optical performance of left and right lenses when the diopter prescription differs by a specific amount. Kitani (5,710,615) and Guirao (6,511,180) do not disclose matching the base curves of the right and left lenses while simultaneously matching astigmatism, field curvature, or distortion.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

8. Claims 7, 9-11, and 13 are objected to because of informality in claim 7, but would be allowable if the informality is corrected appropriately.

The following is a statement of reasons for the indication of allowable subject matter: The prior art taken either singularly or in combination fails to anticipate or fairly suggest the limitations of claims 7, 9-11, and 13, in such a manner that a rejection under 35 U.S.C. 102 or 103 would be proper.

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The prior art fails to teach a combination of all the features in claim 7. For example, these features include the detailed structure of the spectacle lens supply system, including the structural limitations implied by the functional limitations. The system includes the limitation “which is selected among astigmatism, curvature of field, and distortion”, which is not disclosed in Kato (6,199,983, cited in paper no. 10 of June 3, 2001), the reference used as the modifying reference for the limitation of matching new and old optical performances. Kato discloses correcting a design parameter so that it becomes closer to the previous lens design parameter (col. 18, lines 8-12). However, the Kato design parameters are the construction specifications for the lens, such as the refractive power in the near and far zones and the cylinder power, which corrects for the eye’s astigmatism, but not the effective astigmatism, curvature of field, or distortion of the lens. Those types of optical performance are not matched.

Hayashi et al. (5,767,940) also discloses matching the cylinder power of old and new lenses, but not the optical performance.

Claims 9-11 and 13 depend on claim 7 and therefore have allowable subject matter as well.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after



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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah A. Raizen whose telephone number is (571) 272-2336. The examiner can normally be reached on Monday-Friday, from 10:00 a.m. to 3:00 p.m. Eastern Standard Time (a part-time schedule).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 (please note that this number is different from the previous two numbers provided until the summer of 2003).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). The Patent EBC is a complete customer service center that supports all Patent e-business products and

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service applications. External customers should be directed to EBC representatives, who can be reached at **703-305-3028 or toll free at 866-217-9197** between the hours of **6 a.m. and midnight Monday through Friday EST**, or by e-mail at: **[ebc@uspto.gov](mailto:ebc@uspto.gov)**. Additional information is available on the Patent EBC Web site at: **<http://www.uspto.gov/ebc/index.html>**.

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